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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/538,459	12/12/2007	Robert R. Boyd	22198(2)US	3869
24116 7590 08/25/2010 BATTELLE MEMORIAL INSTITUTE 505 KING AVENUE COLUMBUS, OH 43201-2693			EXAMINER TYSON, MELANIE RUANO	
			ART UNIT 3773	PAPER NUMBER
			MAIL DATE 08/25/2010	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/538,459	Applicant(s) BOYD ET AL.	
	Examiner MELANIE TYSON	Art Unit 3773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-12,16-18,20,21,27,30-35,38,39 and 41-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-12,16-18,20,21,27,30-35,38,39 and 41-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>12/4/06, 12/11/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 5-10, 16-18, 21, 27, and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Jacobsen et al. (U.S. Patent No. 6,530,934 B1). Jacobsen discloses a fastener device (see entire document) comprising an articulated compression member (for example, see Figure 11) and a tensioning member (206, 208), wherein the compression member includes an angled surface (for example, see Figure 11), a heat sealing element (an adhesive activated by body heat; for example, see column 4, lines 44-47), is selectively adjustable to deform into a plurality of shapes (including helical; for example, see column 10, line 57 - column 11, line 8), includes a plurality of interconnected sections or compression members (for example, see Figure 11), the distal end of the tensioning member is attached to the compression member at a point spaced from the distal and proximal ends (for example, see Figure 11), the sections are hollow thus one may be considered a container capable of being ruptured by a user at the time of reconfiguration is so desired, the container may include a medicament (for example, see column 1, lines 43-47), the compression members may be in a nested relationship (for example, see Figure 8), and wherein the fastener may be used, for example, as a clamp or occlusive device.

Claims 31-35, 38, 39, and 41-49 are rejected under 35 U.S.C. 102(b) as being anticipated by Gardiner et al. (U.S. Patent No. 6,607,541 B1). Gardiner discloses a method for fastening (see entire document) comprising the steps of positioning a portion of a fastener (20) having a compression member (26) and a tensioning member (34) in fastening relationship with a portion of material to be fastened (hollow vessel 14; for example, see Figure 2C), applying tension to the tensioning member (via heat), compressing the compression member to a second configuration providing a fastening relationship with the material to at least partially close the hollow structure (via graft vessel 12; for example, see Figure 2D), and releasably securing the tensioning member and maintaining the fastener in the second configuration (when it reaches body temperature), wherein the fastener may comprise one or more helical loops (for example, see Figure 3F), the fastener may comprise a medical device or second portion attached thereto (graft vessel 12 is considered the medical device), the fastener having a curved end is inserted into the material in a generally linear first configuration (for example, see Figure 2C), the inside surface of the hollow member is expanded and an occlusion is opened (the end of the needle tract), and the fastener partially occludes the hollow material when inserted (for example, see Figure 2F).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 4, 11, 12, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jacobsen et al.

Regarding claim 4, detection devices are well known in the art for tracking, positioning, and deploying medical devices within the body. Therefore, to include a well known detection device in Jacobsen's invention would have been obvious to one having ordinary skill in the art at the time the invention was made in order to properly position and deploy Jacobsen's device.

Regarding claims 11, 12, and 20, the applicant discloses various means may be utilized to apply tension to the tensioning member, thus indicating the disclosed means are merely obvious variations. Since the applicant has failed to disclose the various means provide any benefit over each other or any other well known means, such as a mechanical force, and one having ordinary skill in the art could have substituted any well known means for applying tension to the tensioning member, such a modification would have been an obvious matter of design choice at the time the invention was made.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MELANIE TYSON whose telephone number is (571) 272-9062 and e-mail address is Melanie.tyson@uspto.gov. The examiner can normally be reached on Monday through Thursday 8-7 (max flex).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571) 272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Melanie Tyson/
Examiner, Art Unit 3773
August 24, 2010